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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/926,882    09/10/97    YAMAGATA    S    B208-062-DIV

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LM02/0510

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EXAMINER
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TRAN, T

ART UNIT	PAPER NUMBER
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*10*

2712

DATE MAILED:

05/10/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/926,882**

Applicant(s)  
**Yamagata et al**

Examiner  
**THAI TRAN**

Group Art Unit  
**2712**



☒ Responsive to communication(s) filed on Feb. 22, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

- ☒ Claim(s) 32-48 is/are pending in the application.
- Of the above, claim(s) 38-44 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 32-37 and 45-48 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☒ received in Application No. (Series Code/Serial Number) 08/271,230.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 32-38 and 45-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5,719,984 in view of Shimada et al ('772) as set forth in paragraph #3 of the last Office Action.

Claim 47 of this instant application is broader than claim 1 of U.S. Patent No. 5,719,984 and encompass claim 1 of of U.S. Patent No. 5,719,984.

Claims 1-2 of U.S. Patent No. 5,719,984 discloses all the features of the instant claimed invention except for providing reproducing means for reproducing the image information signal, the first identification information signal and/or the second identification information signal from the recording medium as recited in claims 32 and 45 of this instant application; a reproducing

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heads which reproduces the data signals from the recording medium as recited in claim 34; wherein the reproducing means is arranged to reproduce the video signal together with a plurality of data signals as recited in claim 36; wherein the data signal converting and supplying means is arranged to mix the character signals with the reproduced video signal and to supply the monitor with a mixture signal thus obtained as recited in claim 37; and wherein the discriminating means reads out a check code recorded with the ID data and performs judgement of the basis of the check code as recited in claim 48.

Shimada et al discloses an apparatus for recording additional video signal having reproducing means (A and B of Fig. 1) for reproducing the image information signal, the first identification information signal and/or the second identification information signal from the recording medium; a reproducing heads (A and B of Fig. 1) which reproduces the data signals from the recording medium; wherein the reproducing means is arranged to reproduce the video signal together with a plurality of data signals (column 5); wherein the data signal converting and supplying means is arranged to mix the character signals with the reproduced video signal and to supply the monitor with a mixture signal thus obtained (20 of Fig. 1); and wherein the discriminating means reads out a check code recorded with the ID data and performs judgement of the basis of the check code (14 of Fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide claims 1-2 of U.S. Patent No. 5,719,984 with reproducing means (A and B of Fig. 1) for reproducing the image information signal, the first identification information signal and/or the

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second identification information signal from the recording medium; a reproducing heads (A and B of Fig. 1) which reproduces the data signals from the recording medium; wherein the reproducing means is arranged to reproduce the video signal together with a plurality of data signals (column 5); wherein the data signal converting and supplying means is arranged to mix the character signals with the reproduced video signal and to supply the monitor with a mixture signal thus obtained (20 of Fig. 1); and wherein the discriminating means reads out a check code recorded with the ID data and performs judgement of the basis of the check code (14 of Fig. 1) as taught in Shimada et al in order to simplify superimposing characters on the video signal in recording and reproducing modes.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 32-37 and 45-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimada et al ('722) as set forth in paragraph #5 of the last Office Action.

Shimada et al discloses an apparatus for recording additional video signal having reproducing means (A and B of Fig. 1) for reproducing the image information signal, the first identification information signal and/or the second identification information signal from the recording medium; inputting means (8 of Fig. 1) for receiving the image information signal, the

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first identification information signal and/or the second identification information signal reproduced by the reproducing means; display means (28 of Fig. 1) for displaying an image corresponding to the signal received by the input means; control means (18 and 21 of Fig. 1) for controlling a display action of the display means to change, on a display means, a displaying position of a character image corresponding to the first identification information signal is received alone or together with the second identification information signal by the input means as recited in claim as recited in claim 45; wherein each of the first identification information signal and the second identification information signal is code data corresponds to one of the plurality of kinds of information including those in the year, month, day and the hour, minute, second corresponding to the image information signal (column 6, lines 1-14) as recited in claim 46; means (16 of Fig. 1) for judging whether the ID data recorded on the ID data recording area is effective or null; controlling means (18 and 21 of Fig. 1) for controlling display of the ID data on the basis of a judgement result of the judging means as recited in claim 47; wherein the discriminating means reads out a check code recorded with the ID data and performs judgement on the basis of the check code (14 of Fig. 1) as recited in claim 48; reproducing means (A and B of Fig. 1) for reproducing the data signals from the recording means; display mode setting means (column 5, lines 54-63) for controlling an amount of the data signals to be displayed and having at least first and second modes involving respective different display amounts; data signal converting and supplying means (10, 19-20, and 29 of Fig. 1) for converting the data signal reproduced by the reproducing means into character signal and for supplying the character signals

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to a monitor, the data signal converting and supplying means being controlled by the display mode setting means to supply the character signals to the monitor in the respective different display amount as recited in claim 32; wherein the recording means is a recording medium (T of Fig. 1) as recited in claim 33; wherein the reproducing means includes a reproducing heads which reproduces the data signals from the recording medium (A and B of Fig. 1) as recited in claim 34; wherein the data signal converting and supplying means is arranged to effect display in respective different display position (column 6, lines 1-14) as recited in claim 35; wherein a video signal is recorded on the recording means together with the plurality of data signals (columns 5-6); wherein the reproducing means is arranged to reproduce the video signal together with the data signals (column 5) as recited in claim 36; and wherein the data signal converting and supplying means is arranged to mix the character signals with the reproduced video signal and to supply the monitor with a mixture signal thus obtained (20 of Fig. 1) as recited in claim 37.

### ***Response to Arguments***

5. Applicant's arguments filed Feb. 22, 2000 have been fully considered but they are not persuasive.

In re pages 1-3, applicants argue that claims 1 and 2 of the '984 patent taken with the teachings of the Shimada et al patent or the teachings of the Shimada et al patent taken alone fail to teach or suggest different modes of operation in which a plurality of data signals

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corresponding to characters are reproduced to retrieve the characters and the characters are displayed in different amounts associated with the different modes as recited in independent claim 32.

In response, Shimada et al discloses in column 4, lines 1-15 that "When the bits of this signal are "11", for example, the channel change-over circuit --- and audio signal L + R is recorded in DATA 1 and a signal L - R in DATA 2, respectively" and in column 5, lines 16-45 that "The character video signal recorded as mentioned above is reproduced in the following manner --- whereby the playback character video signal is stored in the video RAM(10) at the timing shown in FIGS. 5H and 5I". From the above passages, it is clear that Shimada et al does indeed teach or suggest different modes of operation in which a plurality of data signals corresponding to characters are reproduced to retrieve the characters and the characters are displayed in different amounts associated with the different modes (mode "11", mode "01", and mode "10" in which characters are recorded in both track portions DATA 1 and DATA 2, characters are recorded in DATA 2, and no character is recorded, respectively).

In re pages 3-4, applicants argue that claims 1 and 2 of '984 patent and Shimada et al patent do not teach judging whether recorded ID data is effective or null and then controlling the display thereof based on the judgement.

In response, Shimada et al discloses in column 4, lines 1-15 that "When the bits of this signal are "11", for example, the channel change-over circuit --- and audio signal L + R is recorded in DATA 1 and a signal L - R in DATA 2, respectively" and in column 5, lines 16-45



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that "The character video signal recorded as mentioned above is reproduced in the following manner --- whereby the playback character video signal is stored in the video RAM(10) at the timing shown in FIGS. 5H and 5I". From the above passages, it is clear that Shimada et al does indeed teach or suggest the claimed capability of judging whether recorded ID data is effective or null and then controlling the display thereof based on the judgement.

In re pages 4, applicants argue that claim 45 and its dependent claims patentably distinguish over claims 1 and 2 of the '984 patent taken with the Shimada et al patent and over the Shimada et al patent taken alone because the cited art does not teach or suggest the claimed display means displays reproduced image information, first identification information and/or second identification information and the display means is controlled to change the display position of a character image depending upon whether the first identification signal is reproduced alone or with the second identification.

In response, Shimada et al discloses in column 4, lines 1-15 that "When the bits of this signal are "11", for example, the channel change-over circuit --- and audio signal L + R is recorded in DATA 1 and a signal L - R in DATA 2, respectively" and in column 5, lines 16-45 that "The character video signal recorded as mentioned above is reproduced in the following manner --- whereby the playback character video signal is stored in the video RAM(10) at the timing shown in FIGS. 5H and 5I". From the above passages, it is clear that Shimada et al does indeed teach or suggest the limitations of claim 45.

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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725.

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**Any response to this action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-6306, (for formal communications intended for entry)

**Or:**

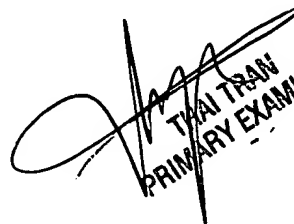
(703) 308-6296 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

TTQ

May 7, 2000

  
THAI TRAN  
PRIMARY EXAMINER